IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant

George Bradley Hobbs

Examiner: Saeld Ebrahimi-Dehkordy

Serial No.:

09/734,295

Group Art Unit: 2623

Filed:

December 11, 2000

Docket No.: 10003974-1

Title:

PRINT PROCESSING SYSTEM AND METHOD WITH PRINT JOB

ADVERTISING

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DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1,131

Commissioner for Patenty P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir/Madam:

This Declaration is submitted to establish prior invention of the subject matter of the present patent application in the United States. The person making this Declaration is the inventor George Bradley Hobbs,

Accompanying this Declaration are Exhibits A through E to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994 coupled with due diligence from prior to the earliest effective date of the Kawai patent up to the filing date of the present patent application (i.e., constructive reduction to practice).

Declaration under 37 C.F.R. § 1.131

Serial No.: 09/734,295 Filed: December 11, 2000 Docket No.: 10003974-1

TMC: FRINT PROCESSING SYSTEM AND METHOD WITH PRINT FOR ADVERTISING

Exhibit A (3 pages) includes a copy of HP Invention Disclosure No. 10003974 submitted by the inventor George Bradley Hobbs and received by the HP Legal Department prior to the earliest effective date of the Kawai et al. US Patent No. 6,404,994. This invention disclosure describes subject matter of the present patent application.

Exhibit B (1 page) includes a copy of a letter from HP Patent Attorney-Outsourving Manager Steven R. Ormiston to patent attorney Steven E. Dicke of Dicke, Billig & Czaja dated June 7, 2000 (a date prior to the earliest affective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994), requesting a quote of the cost to prepare and file a U.S. patent application based on HP Invention Disclosure No. 10003974-1 (i.e., the present patent application).

Exhibit C (1 page) includes a Request for Quote and Engagement Letter Agreement for the preparation and filing of a US patent application based on HP Docket No. 10003974-1 (i.e., the present patent application). The agreement was signed by patent attorney Steven E. Dicke of Dicke, Billig & Czaja on June 13, 2000 and by HP Patent Attorney-Outsourcing Manager Steven R. Ormiston on June 19, 2000 (dates prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994).

Exhibit D (2 pages) includes a copy of an invoice dated November 1, 2000 from Dicke, Billig & Czaja to Hewlett-Packard Company for the preparation of the patent application based on EP Invention Disclosure No. 10003974-1 (i.e., the present patent application). From this invoice, it can be seen that acts in preparation of the patent application occurred between at least June 14, 2000 (a date prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Fatent No. 6,404,994) and October 31, 2000.

HP Invention Disclosure No. 10003974-1 (i.e., the present patent application) was one of a group of related disclosures (10003974-1 and 10003973-1) for which related patent applications were prepared, as identified in the "Cross-Reference to Related Applications" of the present patent application. These related applications were part of a docket of cases prepared by patent attorneys Steven E. Dicke and Scott A. Lund of Dicke, Billig, & Czaja between at least June 14, 2000 (a date prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994) and October 31, 2000. Work on these related applications contributed substantially to the ultimate preparation of the present patent application.

4/12

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Declaration under 37 C.F.R. § 1.131

Serial No.: 09/734,295 Filed: December 11, 2000 Docket No.: 10003974-1

THE: PRINT PROCESSING SYSTEM AND METHOD WITH PRINT JOB ADVERTISING

Exhibit E (1 page) includes a copy of a letter from patent attorney Steven E. Dicke of Dicke, Billig & Czaja to HP Patent Attorney-Outsourcing Manager Steven R. Ormiston dated October 31, 2000. This Letter was accompanied by a draft of the patent application prepared for HP Invention Disclosure No. 10003974-1 (i.e., the present patent application) as reviewed and approved for filing by the inventor. The patent application was subsequently filed on December 11, 2000.

From these exhibits, it can be seen that the subject matter of the present patent application was conceived in the United States prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994 coupled with due diligence from prior to the earliest effective date of the Kawai patent up to the filling date of the present patent application (i.e., constructive reduction to practice).

As a person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jacopardize the validity of the application or any patent issued thereon.

Name: Nemel B. My Mare: 1/68
George Bradley Hobbs

EXHIBIT A

	201.001/75		PAGE ONE OF	
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EXHIBIT A

Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and deled by the inventor(s) and witness(as). Description of the construction and operation of the invention (include appropriate schematic, block, & liming diagrams; drawings; samples; graphs; flowelparts; computer listings; test respite; etc.) A system for allowing customers to allow other businesses to put advertising on a print Job for pay or mutual benefit. For example, a Building contractor designs a brochure to explan his contracting service. The electronic Job Holcet for submitting the Job identifies the construction and home ood bashess along with custoners who would ge the printed Material, # etc That describes The advertising target oner related businesses concil submit Target fields + customers Trey would like to advertise too along with what they would pay In this example, a building c. Problems solved by the tovertion products company would potentially, for the print Job if they would put an ad on the back or a cupon for buying their product Advantages. Connectors advertisers with Print Job creating D. Prior equations and their discoventages (if available, stinch copies of product literature, technical articles, patents, etc.). automatrally based on attributes of the print tob type + distribution. Also, selling The space currently not used on paper for matual benefit.

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Hewlett-Packard Company Legal Department 11311 Chinden Boulevard MS 314 Boise, Idaho 83714 Fax: 208/396-3958

June 7, 2000

EXHIBIT B

Steven R. Dicke
Dicke Billig & Czaja PA
Suite 1250 701 Building
710 Fourth Ave. South
Minneapolis, MN 55415

01/07/2008 16:13 FAX 612 573 2005

Re: Preparation and Filing of Patent Applications for the attached Invention Disclosures

暖

File Directly To USPTO by: November 12, 2000

PDNO's: 10003974-1; 10003975-1; 10003979-1

10003981-1

Dear Steve:

We would like you to provide us with a quote of the cost for your firm to prepare and file (direct with the USPTO) a US patent application based on the HP invention disclosure identified above, a copy of which is enclosed. Your quote should be based on preparing and filing the application as specified on the attached green checklist.

You must use HP's USPTO forms and only reference HP's docket number on all filling documents and correspondence with the USPTO. All filling fees should be charged to HP's deposit account noted on the HP forms. Please do not prepare or file an assignment, HP will do that. Any questions regarding HP's forms and the JetForm software for use with HP's forms should be directed to Jennifer Torres at (650) 857-5796.

Your quote should be submitted on the enclosed Request for Quote And Engagement Letter Agreement. If your quote is accepted, we will return a fully executed copy of the Agreement to you for your records. The Agreement will not be binding on you or on HP until signed by HP's authorized representative.

If this Agreement is not signed and returned to HP, any bills submitted by you cannot be paid.

for Steven R. Ormiston

Sincerely yours,

Green R. Ormiston

Patent Attorney-Outsourcing Manager

SRO/yb

Enc: Invention Disclosure

Request for Quote/Agreement

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DICKE BILLIG & CZAJA, A. 39503490

Patent • Trademark • Copyright **ATTORNEYS**

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolls, Minnesota 55415
Telephone: (612) # 12006 1 V 2005

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Hewlett-Packard Company Pinancial Administrator

HP LEGAL FINANCE Legal Department, Finance Section

ACCOUNT No: 302-128101M 6476

Statement No:

P.O. Box 10301

Palo Alto CA 94303-0890 U.S.A.

LRS/SRO

Attn: Lane Simmons

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Stephen R. Ormiston, Esq. HP Docket No.: 10003974-1 **EXHIBIT D**

Pees

06/14/00 Analyze invention disclosure; Discussions with HP inventors RE:HP trip.

06/26/00 preparing for and in inventor conference

06/27/00 Discussion of invention disclosure with B. Hobbs and D. Palmer at HP - Boise.

09/26/00 preparing for and in inventor conference

10/11/00 drafting claims and preparing specification for patent application

10/12/00 drafting claims for patent application; preparing drawings and specification for patent application

10/13/00 preparing specification for patent application

10/18/00 preparing specification for patent application

10/19/00 preparing specification for patent application

10/20/00 preparing specification for patent application

10/27/00 Discussions with S. Lund; Review patent application.

10/31/00 preparing specification for patent application Prepare/review application filing papers; filing of application with U.S. Patent Office.

For Current Services Rendered



Clett-Packard Company

Page: 2 11/01/00

Account No: 302-128101M 6476 Statement No:

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Stephen R. Ormiston, Esq. HP Docket No.: 10003974-1

EXHIBIT D

Expenses

10/19/00 Patent Request

10/19/00 Patent Request

10/31/00 Long Distance Phone Charges

10/31/00 Photocopy Charges

10/31/00 Postage (First class mail, Express Mail, Federal Express, etc.)

Total Expenses

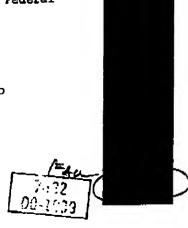
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06/26/00 Travel Expenses - plane fare to Boise, ID

Total Advances

Total Current Work

Balance Due



**TERMS: NET 30 DAYS FROM DATE OF INVOICE Payments received after the first of the month will reflect on next month's statement. For questions regarding your. account, please call Tammy at (612) 573-0079.

O CZAJA, P.A.

Patent • Trademark • Copyright ATTORNEYS

Sulte 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415 Tolephone: (612) 573-2000 Facsimile: (612) 573-2005

Steven E. Dicks Direct Dial: (612) 573-2002

EXHIBIT E

October 31, 2000

Steven R. Ormiston, Esq.
HEWLETT-PACKARD COMPANY
Legal Department
11307 Chinden Boulevard, M/S 314
Building #7
Boise, ID 83714

via Federal Express
B22473219820

RE:

U.S. Patent Application

PRINT PROCESSING SYSTEM AND METHOD WITH

INTERFACE ADVERTISING HP File No.: 10003973-1 DBC File No.: H302.125.101

U.S. Patent Application

PRINT PROCESSING SYSTEM AND METHOD WITH

PRINT JOB ADVERTISING HP File No.: 10003974-1 DBC File No.: H302.128.101

Enclosed for your review are the above-identified patent applications. These applications have been approved by the inventors. After I hear from you, I will proceed with obtaining inventor signatures and filing these applications with the USPTO.

If you have any questions regarding this matter, please contact me at (612) 573-2002.

Regards,

DICKE, BILLIG & CZAJA, P.A.

Steven E. Dicke

SED:SAL:jac Enclosures